

Appl. No. : 10/009,575
Filed : August 6, 2002

REMARKS

In response to the Office Action mailed January 4, 2005, Applicant has amended the application as above. No new matter is added by the amendments as discussed below. Applicant respectfully requests the entry of the amendments and reconsideration of the application in view of the amendments and the remarks set forth below.

Discussion of Claim Amendments

Claims 19, 29-30 and 36 have been amended. Upon the entry of the amendments, Claims 19-36 are pending in this application. The amendments to the claims are supported, for example, by the specification at page 5, line 29 through page 6, line 8, and Figure 2. Thus, the amendments to the claims do not introduce any new matter. Entry of the amendments is respectfully requested.

Discussion of Claim Rejections Under 35 U.S.C. § 103(a)

The Examiner has rejected Claims 19-36 under 35 U.S.C. § 103 (a) as being unpatentable over Olivier (U.S. Patent No. 6,480,885) and Ogilvie (U.S. Patent No. 6,324,569). Applicant respectfully traverses the Examiner's claim rejections as discussed below.

Standard of *Prima facie* Obviousness

In order to provide a *prima facie* showing of obviousness under 35 U.S.C. § 103(a), all the claim limitations must be taught or suggested by the prior art. *See, e.g., In re Royka*, 490 F. 2d 981, 180 U.S.P.Q. 580 (CCPA 1974); MPEP 2143.03.

Patentability of Pending Claims 19-36

Each of amended Claims 19, 29-30 and 36 recites, among other things, providing the recipient with an option to view the unapproved message and selectively delete the message, without using a self-removing message indicator, after viewing. Applicant respectfully submits that neither Olivier nor Ogilvie teaches or suggests the above-recited features.

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1. Olivier Neither Teaches Nor Suggests “providing the recipient with an option to view the unapproved message and selectively delete the message, without using a self-removing message indicator, after viewing”

Olivier is concerned with managing a subscription mailing list and improvements to that process. *See column 3, lines 35-60.* Olivier further states that:

If the message isn't approved or rejected after 5 days or another period of time, it is removed from the database and returned to the sender. If a moderator approves the message, it is then sent to the distribution list. If it is rejected, the sender is informed via email. In either case the message is then removed from the suspended messages table.

See column 15, lines 9-15 of Olivier

In Olivier, if a message is unapproved or rejected, the sender, not the recipient, is notified about the unapproval. The recipient is not notified about the unapproval of the message. Furthermore, such a rejected message is not sent to the recipient. Thus, Olivier cannot, and does not, teach or suggest “providing the recipient with an option to view the unapproved message and selectively delete the message, without using a self-removing message indicator, after viewing” recited in independent Claims 19, 29-30 and 36.

Furthermore, Olivier does not teach or suggest “notifying the recipient and storing the message if the message is unapproved.” The Examiner asserts, citing column 16, lines 25-62, that Olivier discloses “once the notification is set in the message criteria data, the recipient will automatically receive an acknowledgment as to whether a message is approved or not.” Applicant respectfully disagrees. The cited portion does not describe any feature that notifies the recipient when an email is unapproved. That passage deals with the automatic distribution of emails to participants of an email discussion. The participants of a discussion are represented by a list of email addresses stored on a database and when an email is sent to a specially encoded email address, the server will automatically copy the emails to all the participants of the discussion corresponding to the specially encoded email address. This feature has no relevance to the claim term “notifying the recipient and storing the message if the message is unapproved.”

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In a mailing list environment, there is no point or need to notify recipients of emails that are unapproved, and store such emails.

2. Ogilvie Neither Teaches Nor Suggests “providing the recipient with an option to view the unapproved message and selectively delete the message, without using a self-removing message indicator, after viewing”

Ogilvie is directed to automatic deletion of an undesirable message in order to reduce a recipient's burden to manually delete spam mails. *See column 2, lines 32-45.* Ogilvie further states that:

During a creating step 204 the originator 200 creates a self-removing message 206 using software and hardware configured by the software, or using custom hardware alone, according to the teachings herein. This may be done generally in accordance with familiar tools and techniques for email messaging, attaching files, embedding graphics, encrypting data, and/or compressing data, but it must associate code and/or hardware 208, and/or indicators 210, with the message 206 to perform or facilitate the self-removal message management functions described here. That is, the originator 200 (or equivalently, an embodiment under the originator's direction) marks the message 206 at the origin, includes removal code 208 in the message 206, or does both.

See column 5, lines 6-18 of Ogilvie

In order to automatically delete an unapproved message (its intended function), Ogilvie is required to use a self-removal indicator (or code). Thus, the Ogilvie patent cannot, and does not, teach or suggest “providing the recipient with an option to view the unapproved message and selectively delete the message, *without using a self-removing message indicator, after viewing*” recited in independent Claims 19, 29-30 and 36.

3. There is No Motivation or Suggestion to Modify Prior Art References to Arrive at the Claimed Invention

Applicant respectfully submits that there is no motivation or suggestion to modify the Ogilvie system to arrive at the claimed invention. As discussed above, in order to perform its intended function, the Ogilvie system must include a self-removal indicator or code in an email message to be transmitted. If the Ogilvie system were modified to delete a self-removal indicator

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or code from the email message, such modification would render the Ogilvie device inoperable for its intended purpose because an unapproved message would not be automatically deleted at a recipient's computer. *MPEP 2143.01*.

Furthermore, Applicant respectfully submits that there is no motivation or suggestion to modify the Olivier system to arrive at the claimed invention. As discussed above, in a mailing list environment such as in Olivier, there is no point or need to "notify recipients of emails that are unapproved and store such emails" let alone "provide the recipient with an option to view the unapproved message and selectively delete the message, without using a self-removing message indicator, after viewing." Thus, a skilled person would not have been motivated to modify the Olivier system as in the claimed invention.

In view of the above, Applicant respectfully submits that there is no motivation or suggestion to modify the Ogilvie and Olivier systems to arrive at the claimed invention.

4. Summary

As discussed above, neither Olivier nor Ogilvie teaches or suggests "providing the recipient with an option to view the unapproved message and selectively delete the message, without using a self-removing message indicator, after viewing" recited in independent Claims 19, 29-30 and 36. Furthermore, there is no motivation or suggestion to modify the prior art references to arrive at the claimed invention. In view of the above, independent Claims 19, 29-30 and 36 are allowable over the prior art of record. Claims 20-28 and 31-35 depend from base Claim 19 or 30, and further define additional technical features of the present invention. In view of the patentability of their base claims, and in further view of their additional technical features, Applicant respectfully submits that the dependent claims are patentable over the prior art of record.

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CONCLUSION

In view of Applicant's foregoing amendments and remarks, it is respectfully submitted that the present application is in condition for allowance. Should the Examiner have any remaining concerns which might prevent the prompt allowance of the application, the Examiner is respectfully invited to contact the undersigned at the telephone number appearing below.

Respectfully submitted,

KNOBBE, MARTENS, OLSON & BEAR, LLP

Dated: _____

5/3/05

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